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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/995,880

11/28/2001

Thomas A. Koes

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EXAMINER

LEE, SIN J

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

12/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/995,880 | Applicant(s) KOES, THOMAS A. | |
| | Examiner Sin J. Lee | Art Unit 1795 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,8-12,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8-12, 17, 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the amendment, previous 112, second paragraph rejection on claims 12, 17 and 18 is hereby withdrawn.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

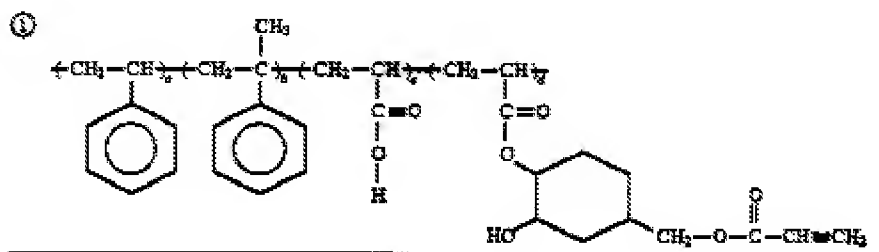
Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 6-12, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Urano et al (5,800,952) (with Yamada et al (6,033,829) which is being cited here to show that 2-mercaptobenzothiazole is a compound that is added to a photopolymerizable composition to further increase performance of a photopolymerization initiator).

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In Comparative Examples 6 and 9 (see Table 2, and see also the last three lines of col.15-16, first fifteen lines of col.17-18, and col.4, lines 15-17, col.16, lines 48-58), Urano teaches a photopolymerizable composition containing a photopolymerization initiator system II including R-1 (2,2'-bis(o-chlorophenyl)-4,4',5,5'-tetraphenylbiimidazole), Michler's ketone (N,N'-tetramethyl-4,4'-diaminobenzophenone) and 2-mercaptobenzothiazole, an ethylenic compound, 24 parts of an organic polymer material (1) (with acid value of 80) which is shown below, and 3 parts of an additive which is one of oxalic acid and phthalic acid:



Therefore, Urano teaches present 5 parts of the organic acid per 40 parts of polymeric binder. Urano coats his composition onto a substrate, followed by exposure and development. Thus, Urano teaches present inventions of claims 1, 6-12, 17 and 18; even though present claim 1 recites "[a] photoresist composition consisting essentially of . . .", it is the Examiner's position that 2-mercaptobenzothiazole of Urano's composition would not materially affect the basic and novel characteristic(s) of the claimed invention because 2-mercaptobenzothiazole is merely a compound that is added to a photopolymerizable composition to further increase performance of a photopolymerization initiator as evidenced by Yamada, col.10, lines 7-14. Thus, it is the

Examiner's position that Urano's composition still teaches present composition. See MPEP 2111.03.

Response to Arguments

5. Applicants argue that the Examiner has improperly extrapolated the teachings of Yamada to Urano. Applicants argue that in Yamada, the 2-mercaptobenzothiazole is not an essential element whereas in Urano, the 2-mercaptobenzothiazole is the only initiator and thus an essential element. Therefore, applicants conclude that if 2-mercaptobenzothiazole were present in present composition its presence would materially affect the basic and novel characteristics of the claimed composition and that therefore the 2-mercaptobenzothiazole is excluded from present composition.

The Examiner disagrees. First of all, in Urano's Comparative Example 6 and 9, 2-mercaptobenzothiazole is *not* the only initiator. Those examples use a photopolymerization initiator system, which also includes 2,2'-bis(o-chlorophenyl)-4,4',5,5'-tetraphenylbimidazole and N,N'-tetramethyl-4,4'-diaminobenzophenone. Those compounds are clearly initiators that generate radicals upon absorption of light (see Urano, col.4, lines 10-17, line 32). Secondly, the issue here is *not* whether the 2-mercaptobenzothiazole is an essential element or not in Urano but whether the presence of such compound *would materially affect the basic and novel characteristic(s) of the claimed present invention*. As stated before, it is still the Examiner's position that 2-mercaptobenzothiazole of Urano's composition would not materially affect the basic and novel characteristic(s) of the claimed invention because 2-

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mercaptobenzothiazole is known in the art as a compound that is added to a photopolymerizable composition to further increase performance of a photopolymerization initiator as evidenced by Yamada. As stated previously, if an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," ***applicant has the burden*** of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989). See MPEP 2111.03. It is the Examiner's position that applicants have not met such a burden.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sin J. Lee/

Primary Examiner, Art Unit 1795

December 16, 2008